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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,699	10/16/2003	Fred Hartnett	200209079-1	9165

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EXAMINER

KOBERT, RUSSELL MARC

ART UNIT PAPER NUMBER

2829

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/686,699	Applicant(s) HARTNETT ET AL.	
	Examiner Russell M. Kobert	Art Unit 2829	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 14-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1003</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2829

1. Applicant's election with traverse of claims 1-13 in the reply filed on 5 July 2005 is acknowledged. The traversal is on the ground(s) that the Examiner has not met the burden of establishing a prima facie restriction requirement and that no reasons are relied upon by the examiner for holding the "inventions" as claimed as being independent or distinct. Moreover, Applicants further argue that the Examiner has provided nothing more than a conclusion and no basis or reasoning as to why a restriction on Figures 1 and 3 is supported. This is not found persuasive because Applicants have not shown that the species (not Inventions) are not patentably distinct. Moreover, by Applicants' own admission in the specification, according the Summary of the Invention, there exists separate embodiments as evidenced by the phrases "one embodiment," "another embodiment," and "yet another embodiment." Additionally, by Applicants' own admission in the specification, according the Brief Description of the Drawings, there exists "an embodiment" (Figure 1) as recited in line [0008] and there exists yet "another embodiment" (Figure 3) as recited in line [0010]. Embodiments are species. Admission on the record by Applicants that the species are not patentably distinct will result in rejoinder. With regard to the "no burden" argument, it is noted that each distinct species beyond one is a burden in that it draws the attention of the Examiner to its own requirements. Examination requires focus to follow search leads and patterns of logic in formulating applications of the prior art to that which is claimed. When the Examiner has to pursue several search patterns of logic simultaneously or serially, added burden is presented. In order to examine several inventions and/or species simultaneously or serially, added effort beyond that necessary for one invention

Art Unit: 2829

or species must be expended. Where the effort is serial and the jobs are different the added burden is obvious. Digging two equal holes of the same size requires twice the effort of digging one hole. Such is an obvious conclusion. It can be argued that some inventions or species can be examined simultaneously but such is true only if they are not patentably distinct, that is, **if that which applies to any one applies to all others**. Where inventions or species are patentably distinct each requires separate consideration. As a for instance, consider a properly restrictable apparatus and method of use of that apparatus where one has details without correspondence in the other. Finding references anticipating or making obvious one does not necessarily render the other unpatentable. Having to examine the other constitutes a burden. If the apparatus and method of the above example are not patentably distinct no burden is presented in examining both since if one falls the other falls as well. As a second for instance, consider a properly restrictable combination and subcombination where all the details of the subcombination are not necessary for the combination. Finding references anticipating or making obvious one does not necessarily render the other unpatentable. Having to examine the other is a burden. If the combination and subcombination of the above example are not patentably distinct no burden is presented in examining both since if one falls the other falls as well. Admission on the record that the species are not patentably distinct will result in rejoinder.

It is further noted that although Applicants failed to identify which species is elected, the Examiner will consider the elected claims, as being drawn to at least one of the species and sub-species.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 14-27 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 5 July 2005.

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. A good example of such a title, although not necessarily related to this specific case, could be "*Method and Apparatus for Passive Optical Characterization of Semiconductor Substrates Subjected to High Energy (MEV) Ion Implantation Using High-Injection Surface Photovoltage.*"

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 and 3-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Dunlap et al (6373268).

Dunlap et al anticipates (Figures 5, 9, 11, 12A-E and 14) an electronic circuit assembly test apparatus, comprising:

a support member (202) having a plurality of probes (72), each probe adapted to contact a corresponding test area of an electronic circuit assembly (44); and

a probe assembly (206) coupled (via 204) to the support member, the probe assembly having a plurality of probes (209), wherein a spacing density of the probes of the probe assembly is greater than a spacing density of the probes of the support member (see Figure 11 and col 5, ln 14-20; note reference to "wider distribution"); as recited in claim 1.

Dunlap et al anticipates an electronic circuit assembly test apparatus (Figures 5, 9, 11, 12A-E and 14), comprising:

first probe means (72) coupled to a support member (202) and adapted to contact corresponding test areas on an electronic circuit assembly (44);

support means (204) coupled to the support member; and

second probe means (206) coupled to the support means, the second probe means having a spacing density of probes greater than a spacing density of probes of the first probe means (see Figure 11 and col 5, ln 14-20; note reference to "wider distribution"); as recited in claim 9.

Moreover, the limitations of claims 3-8 and 10-13 are considered inherent in the apparatus of Dunlap et al or are within the normal range of operating the apparatus of Dunlap et al.

6. Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Bardsley et al (6094056).

Bardsley et al anticipates (Figures 8 and 9) an electronic circuit assembly test apparatus, comprising:

a support member (that portion of 134 containing pins 138) having a plurality of probes (138), each probe adapted to contact a corresponding test area of an electronic circuit assembly (132); and

a probe assembly (that portion of 134 containing pins 136 and 137) coupled (not vertical line separating portions of 134 containing pins 138 from that containing pins 136 and 137) to the support member, the probe assembly having a plurality of probes (136 and 137), wherein a spacing density of the probes of the probe assembly is greater than a spacing density of the probes of the support member (note spacings shown in Figures 8 and 9); as recited in claim 1.

Bardsley et al anticipates an electronic circuit assembly test apparatus (Figures 8 and 9), comprising:

first probe means (138) coupled to a support member (that portion of 134 containing pins 138) and adapted to contact corresponding test areas on an electronic circuit assembly (132);

support means (136) coupled to the support member; and

second probe means (137) coupled to the support means, the second probe means having a spacing density of probes greater than a spacing density of probes of the first probe means (note spacings shown in Figures 8 and 9); as recited in claim 9.

Art Unit: 2829

As to claim 2, having the spacing density of the probes of the probe assembly corresponding to test areas of an integrated circuit is anticipated by Bardsley et al (note correlation shown in Figure 8 between 124 and pins 137).

As to claim 3, having the probe assembly adapted to move laterally relative to the support member is considered an inherent property of the apparatus taught by Bardsley et al.

As to claim 4, having alignment guides disposed on the electronic circuit assembly is inherent by the coupling shown in Figure 8 of pins 136.

As to claim 5, having at least one limiter adapted to limit movement of the probes of the probe assembly toward the electronic circuit assembly is inherent to the construction shown in Figure 8.

As to claim 6 having the probe assembly movably coupled to the support member to provide non-lateral movement of the probe assembly relative to the support member is inherent because the operation of pins 136 and 137 is intended for vertical movement.

As to claim 7 having spring-biased probes (col 8, ln 27; note "pogo-type") is taught by Bardsley et al.

As to claim 8 having at least one spring disposed between the probe assembly and the support member is met by the use of "pogo-type" pins (col 8, ln 27).

As to claim 10 having the support means being movably coupled to the support member is an inherent characteristic of Bardsley et al.

Art Unit: 2829

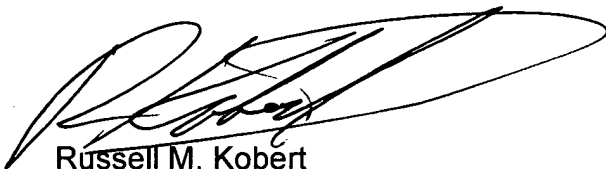
As to claim 11 having the support means coupled to the support member to enable lateral movement of the support means relative to the support member is considered an inherent characteristic of Bardsley et al.

As to claim 12 having means for aligning the second probe means with corresponding test areas of the electronic circuit assembly is anticipated by Bardsley et al.


As to claim 13 having means for limiting travel of the second probe means toward the electronic circuit assembly is inherent to the construction shown in Figure 8.

A shortened statutory period for response to this action is set to expire three month(s) from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell Kobert whose telephone number is (571) 272-1963. The Examiner's Supervisor, Nestor R. Ramirez, can be reached at (571) 272-2034. For an automated menu of Tech Center 2800 phone numbers call (571) 272-2800.



Russell M. Kobert
Patent Examiner
Group Art Unit 2829
September 1, 2005



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09/02/05